

REMARKS

Applicant would like to thank the Examiner for the courteous telephone interview that took place with Examiner Henn, Supervisory Primary Examiner Ometz and the undersigned Counsel on May 10, 2006, and well as for the follow-up telephone discussions which took place later on May 10 and then on May 17, 2006 between Examiner Henn and Counsel. During the first telephone interview, Counsel summarized the prior prosecution and the evolution of the claim amendments, as well as the distinctions of the claimed invention over the cited prior art, and also summarized the case law cited by the Examiner and the reasons why Applicant believes that his position is actually supported by the Examiner-cited case law. At the conclusion of the first telephone interview, it appeared that the Examiner and SPE were receptive to Applicant's position (although no commitment was given), and SPE Ometz suggested a written submission that would include a summary of the distinctions of the claims over the prior art. This is set forth hereinbelow. Later, Examiner Henn telephoned and suggested some possible further claim language. Then, after Counsel consulted with the inventor, Counsel spoke again with Examiner Henn on May 17, and explained why only part of the Examiner's suggested claim language would be suitable. That part of the Examiner's suggestion has now been implemented in the claim amendments hereof.

Independent claim 15 has been amended consistent with the Examiner's

suggestion and now recites, inter alia, the following:

“said means for producing electronic video signals from the output of said sensor including a first register to which are connected solely R pixels, diagonally offset in alternating directions, for successive vertically adjacent lines of a group of lines, a second register to which are connected solely G pixels, diagonally offset in alternating directions, for successive vertically adjacent lines of said group of lines, and a third register to which are connected solely B pixels, diagonally offset in alternating directions, for successive vertically adjacent lines of said group of lines.”

As indicated, the word “solely” has been added with respect to the description of each of the first, second, and third registers.

The Office Action acknowledges that the primary citation, Kawahara U.S. Patent 4,758,883, does not disclose the claim limitation which defines that the means for producing electronic video signals from the output of the sensor includes the elements summarized above, but argues that this feature is obvious in view of the teachings of the Uchiyama et al. U.S. Patent 5,194,944.

Uchiyama et al. discloses an image signal processing apparatus that has a vertical register for storing and transferring color signals, and a horizontal register for receiving color signals transferred from the vertical register. Figures 3 and 4 of Uchiyama illustrate these registers and their operation.

As Counsel pointed out, analysis of the operation of Uchiyama and its registers reveals that they operate to produce B, R, and G signals from image sensing areas and image storage areas using conventional frame transfer CCDs in a conventional

cardinally arranged sequence, and there is no disclosure whatsoever in Uchiyama relating to diagonally offset color pixels or how they would be selected for read-out into registers, as is shown in Figure 5 of Applicant's specification and as set forth in the amended claims. Further, as Applicant has respectfully asked: Why would one skilled in the art seek to use the scheme of Uchiyama with the sensor of Kawahara et al., in the absence of Applicant's teachings and hindsight? Further, the arrangement of Uchiyama, connected with the sensor of Kawahara, would still not give Applicant's claimed apparatus, as the wrong pixels would be coupled to the wrong register taps. Thus, after the Kawahara and Uchiyama teachings are combined, such combination must then still be modified in order for the Examiner to achieve his reconstruction of the invention. The required modification is substantial and not suggested by the teachings of either citation, unless one looks to Applicant's teachings for guidance. The only incentive for modifying the registers of Uchiyama to a diagonally oriented arrangement, with offsets in alternating directions, would come from Applicant's own teachings. Accordingly, the patentability of the amended claims should be evident.

In an outstanding office Action, the Examiner stated:

"In combining the sensor of Kawahara with the readout structure of Uchiyama, the R, G and B pixels would need to be separated during readout into their respective registers, as taught by Uchiyama, in order to maintain the function of simultaneous R, G and B readout. In doing so, the examiner notes that the R, G and B pixels which are diagonally offset in alternating directions for successive vertically adjacent lines of a group of lines would be connected to their respective registers as claimed in claim 15.

“In response to applicant’s argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *in re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *in re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, since Uchiyama discloses motivation (i.e. simultaneous output of R, G and B pixel signals) Applicant’s arguments of hindsight are not considered persuasive.”

As seen from this quoted passage, the Examiner does not now argue that the secondary citation, Uchiyama, actually teaches the readout structure recited in the claim, but rather, in effect, that Uchiyama would have to be modified to operate like Applicant’s claimed readout in order to allow “for simultaneous output of R, G, and B pixel signals” and since “the R, G and B pixels would need to be separated into their respective registers.” The foregoing is tantamount to the Examiner saying that although Uchiyama does not teach what is claimed, it would be obvious to modify Uchiyama to work like the claimed circuit based on the need to do so to achieve what Applicant has achieved. This thesis does not find support in logic, in fairness, or in the case law.

In the Examiner-cited case of *In re Fine*, 832 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), the Court of Appeals for the Federal Circuit reversed the Patent Office Board Of Appeals, and held for the applicant, stating that references can be combined only if there is a suggestion in the art itself to do so, and that hindsight should not be applied.

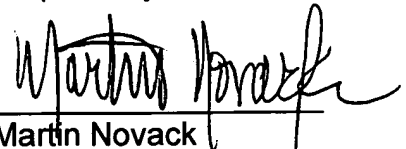
The other case citation, In re Jones, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), also involved a reversal of a Patent Office Board of Appeals rejection. In Jones, the CAFC found the invention at issue to be unobvious, and stated, among other things: "Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed [invention]." These decisions mandate that in a case like the present one, an Applicant's own teachings cannot be used as a basis for modifying a combination of citations in an attempt to reconstruct the claimed invention. The rejections should be vacated.

In view of the foregoing, it is believed that the Application is now in condition for allowance, and such favorable action is earnestly solicited. In the event that the Examiner is not persuaded, it is asked that he kindly telephone the undersigned Counsel collect so that any remaining issues can be resolved.

Delray Beach, FL 33484
Tel. (561) 498-4706
Fax. (561) 498-4027
May 22, 2006

(F-52)

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Martin Novack", written over a horizontal line.

Martin Novack
Registration No. 25,164
Attorney for Applicant(s)